REMARKS

Claim Rejections Under 35 USC §103

Claims 1-10 and 12-15 are rejected under 35 USC §103(a) as being unpatentable over Flannery (U.S. Patent No. 6,424,796) in view of Gilbert (U.S. Patent No. 6,357,011).

Flannery describes an adapter for receiving an optical storage medium drive capable of stand-alone playing of optical storage medium. An interface controller (318) is provided with a SCSI interface for communications to host a computer. Power may be supplied from a battery (420) or an external power supply (422). Flannery does not disclose providing power from the host computer.

Gilbert describes supplying power for peripherals from a serial bus connected to a computer.

Independent claim 1 is amended to indicate as described on page 10, lines 18-22 of the specification that power is supplied from either connector (9) or external power supply inlet (15) depending on which has the higher voltage level. Flannery and Gilbert fail to describe switching between power supplies based on voltage level.

Section 2143 of the MPEP has specifically stated that:

> "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all the claimed limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 466, 20 USPQ2d 1438 (Fed. Cir. 1991)."

Therefore, it is both a court position and a Patent Office position that to establish a *prima facie* case of obviousness, 1) there **must be** some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; 2) there **must be** a reasonable expectation of success; and 3) the teaching or suggestion to make the claimed combination and the reasonable expectation of success **must both be** found in the prior art, and not based on applicant's disclosure.

Therefore, should the Office either be unable to identified each and every aspect of the above-mentioned claimed features after taking full consideration of the asserted prior art in a way exactly applied in the outstanding Office action, or the Office recognizes that the rejection simply does not arise to a level objectively fulfilling all three criteria of establishing a *prima facie* case of obviousness, it is respectfully submitted that the obviousness rejection is defective and allowance of the claimed invention is requested.

Claims 11 and 16 are rejected under 35 USC §103(a) as being unpatentable over Flannery (U.S. Patent No. 6,424,796) in view of Gilbert (U.S. Patent No. 6,357,011) as applied to claims 1-7, 9, 10, 12, 14 and 15 and further in view of Ozawa (U.S. Patent No. 5,870,710).

As independent claim 1 is amended to patentably distinguish over the asserted primary references, all claims dependent theron, by virtue of inherency, are also patentably distinguished over the primary references further in view of whatever secondary reference.

Reconsideration and withdrawal of this rejection are respectfully requested.

Prior Art Indicated To Be Pertinent To The Disclosure

The Office has provided a list of prior art indicated to be pertinent to the Applicant's invention. Consistent with the understanding as stipulated in MPEP 706.02 that only the best prior art should be applied, this list of prior art not having been applied by the Office, it is the Applicant's understanding that the Office must have considered the listed prior art to be no more pertinent than the applied prior art of record.

CONCLUSION

In view of the aforementioned amendments and accompanying remarks, all pending claims are believed to be in condition for allowance, which action, at an early date, is requested.

In the event that this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. Please charge any fees for such an extension of time and any other fees which may be due with respect to this paper, to Deposit Account No. 50-2866.

Respectfully Submitted,

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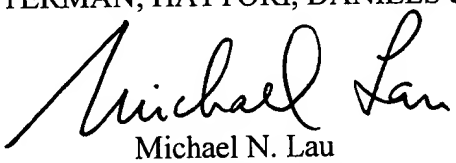

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